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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MITSURU TAKEI and JUNICHI OHTSUKI

Appeal 2009-007271
Application 10/530,558

Decided: February 23, 2010

Before DEMETRA J. MILLS, RICHARD M. LEBOVITZ, and
FRANCISCO C. PRATS, *Administrative Patent Judges*.

MILLS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134. The Examiner has rejected the claims for lack of written description. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF CASE

The following claims are representative.

8. A dental coating kit comprising:

a primer composition including at least one acidic group-containing monomer (a), water (b) and at least one water-soluble solvent (c) comprising a hydrophilic monomer in an amount of at least 10 wt% based on the total weight of the primer composition;

a coating composition having viscosity at 30°C of 300 cP through 50,000 cP and including at least one monomer (d) and at least one photopolymerization initiator (e); and

a surface smoothing composition including at least one polyfunctional monomer (f) at least one volatile solvent (g) and at least one photopolymerization initiator (h).

9. The dental coating kit according to Claim 8,

wherein the primer composition includes the acidic group-containing monomer (a) in an amount of 1 wt% through 90 wt%, the water (b) in an amount of 0.1 wt% through 90 wt% and the water-soluble solvent (c) in an amount of 10 wt% through 98 wt%,

the coating composition includes the monomer (d) in an amount of 40 wt% through 99.99 wt% and the photopolymerization initiator (e) in an amount of 0.01 wt% through 10 wt% based on the monomer (d), and

the surface smoothing composition includes the polyfunctional monomer (f) in an amount of 40 wt% through 98 wt%, the volatile solvent (g) in an amount of 1 wt% through 59 wt% and the photopolymerization initiator (h) in an amount of 0.01 wt% through 10 wt% based on a total weight of monomer(s) included in the surface smoothing composition.

Ground of Rejection

Claims 8-10 and 12-15 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

FINDINGS OF FACT

1. The Examiner finds that the claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
2. The Examiner finds that, the claims recite the limitation “a coating composition having a viscosity at 30°C of 300cP through 50,000 cP and including at least on monomer (d) and at least one photopolymerization initiator (e)... and a surface smoothing composition including ... one polyfunctional monomer (f).” (Ans. 3.)
3. The Examiner finds that the word “monomer”, even when present in an original claim, does not satisfy the written description requirement. (Ans. 4.)
4. The Examiner finds that, the disclosure must allow one skilled in the art to visualize or recognize the identity of the subject matter purportedly described. Based on the instant claims reciting a photopolymerization initiator for each composition, the monomers appear to be photopolymerizable monomers yet the claim recites “monomer” that may encompass “any monomer” and not just those that are photopolymerizable. In the case of the smoothing composition, the Examiner finds that the monomer (f) covers monomers having three or more olefin double bonds but does not disclose examples of what this encompasses such as the structure, the size, what other groups may be included on the monomer, what other

types of monomers are included or if the monomer is photopolymerizable.
(Ans. 4.)

5. The Examiner finds that, with regard to the coating composition, the “monomer” is a hydrophilic and hydrophobic monomers. The examples of the hydrophilic monomer described in the Specification include methacrylic based monomers with a solubility at 25°C of 10 weight % or more and the hydrophobic monomers are esters with a solubility at 25°C of 10 weight % or less. (Ans. 4.)

6. The Examiner finds that, the Specification does not give other examples of hydrophilic monomers or hydrophobic monomers to support the term “monomer” nor does it disclose if the monomers are photopolymerizable monomers considering a photopolymerization initiator is included in the composition. (Ans. 4.)

7. The Examiner finds that the claims recite the limitation “at least one acidic monomer” and that the instant specification discloses the acidic monomer comprises an acidic group “such as a phosphoric group, a pyrophosphoric group, a thiophosphoric group, a carboxylic group or a sulfonic group and also has a polymerizable unsaturated group such as an acryloyl group, a methacryloyl group, a vinyl group or a vinylbenzyl group. In particular, the monomers have an acryloyl group or a methacryloyl group as the unsaturated group is preferred.” (Ans. 5.)

8. The Examiner finds that, although the Specification gives specific examples of acryloyl group or a methacryloyl comprising monomer, it does not disclose examples of other monomers or indicate what other types of monomers are acidic monomers other than the four classes disclosed above. It also does not disclose monomers comprising several acidic groups or

indication how one would determine how many acidic groups are encompassed by “at least one acidic group.” (Ans. 5.)

ISSUE

The Examiner argues that the Specification does not describe sufficient examples of hydrophilic monomers or hydrophobic monomers to support the term “monomer” nor does it disclose if the monomers are photopolymerizable monomers considering a photopolymerization initiator is included in the composition. (Ans. 4.) The Examiner further argues that the Specification does not disclose monomers comprising several acidic groups or indicate how one would determine how many acidic groups are encompassed by “at least one acidic group.” (Ans. 5.)

Appellants contend that the claims are adequately described to show possession of the invention to one of ordinary skill in the art. (Br. 5-6.)

The issue is: Have Appellants demonstrated error in the Examiner’s written description rejection?

PRINCIPLES OF LAW

“The ‘written description’ requirement serves a teaching function, . . . in which the public is given ‘meaningful disclosure in exchange for being excluded from practicing the invention for a limited period of time.’”

University of Rochester v. G.D. Searle & Co., Inc., 358 F.3d 916, 922 (Fed. Cir. 2004). Another “purpose of the ‘written description’ requirement is . . . [to] convey with reasonable clarity to those skilled in the art that, as of the filing date [], [the applicant] was in possession of the invention.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563- 64 (Fed. Cir. 1991). *See also Enzo Biochem Inc. v. Gen-Probe Inc.*, 296 F.3d 1316, 1329 (Fed. Cir. 2002). The requirement is satisfied when the specification “set[s] forth enough detail to

allow a person of ordinary skill in the art to understand what is claimed and to recognize that the inventor invented what is claimed.” *University of Rochester*, 358 F.3d at 928.

Whether or not a specification satisfies the requirement is a question of fact, which must be resolved on a case-by-case basis (*Vas-Cath*, 935 F.2d at 1562-63), and it is the examiner’s “initial burden [to] present[] evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims” (*In re Wertheim*, 541 F.2d 257, 263 (CCPA 1976)).

“Precedent illustrates that the determination of what is needed to support generic claims ... depends on a variety of factors, such as the existing knowledge in the particular field, the extent and content of the prior art, the maturity of the science or technology, the predictability of the aspect at issue, and other considerations appropriate to the subject matter.” *Capon v. Eshhar*, 418 F.3d 1349, 1359 (Fed. Cir. 2005).

“[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.” *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

ANALYSIS

The Examiner argues that the Specification does not describe a sufficient number of examples of hydrophilic monomers or hydrophobic monomers to support the term “monomer” nor does it disclose if the

monomers are photopolymerizable monomers considering a photopolymerization initiator is included in the composition. (Ans. 4.) The Examiner further argues that the Specification does not disclose monomers comprising several acidic groups or indicate how one would determine how many acidic groups are encompassed by “at least one acidic group.” (Ans. 5.) The Examiner argues that the Specification does not disclose monomers comprising several acidic groups or indication how one would determine how many acidic groups are encompassed by “at least one acidic group.” (Ans. 5.)

Appellants contend with respect to the hydrophilic monomers, that the claims are adequately described to one of ordinary skill in the art. (Br. 6.) Appellants indicate that they describe the “monomer,” i.e., at least one monomer (d), in the specification at page 26, line 3 through page 29, line 21. “Applicants describe therein examples of this monomer as well as the properties desired. In addition, as discussed above, since the coating composition requires at least one photopolymerization inhibitor (e), it necessarily follows that at least one monomer (d) necessarily includes monomers which are photopolymerizable.” (Br. 6.) We conclude that one of ordinary skill in the art would understand upon reading the Specification that the claims require a photopolymerizable monomer. Therefore we are not persuaded by the Examiner’s fact finding or argument.

Appellants further argue that the term “at least one acidic group-containing monomer (a)” means there may be more than one monomer having an acidic group, not one monomer having a plurality of acidic groups, although such monomers are not necessarily excluded. (Br. 6.) Thus, Appellants argue that the Specification lists several monomers having

an acidic group, and that one need not use just one of those monomers, but may include several monomers from the listing of monomers with acidic groups. The “acidic group” component is described in the Specification as securing the adhesiveness to teeth, at page 4, lines 14-15. Numerous examples are listed, beginning at page 4, line 14 through page 8, line 21. (Br. 6.) We conclude that “at least one acidic group containing monomer” would have been understood by one of ordinary skill in the art in view of the relevant portions of the Specification to mean at least one monomer which has an acidic group.

It is the examiner’s “initial burden [to] present[] evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims” (*In re Wertheim*, 541 F.2d 257, 263 (CCPA 1976)). We do not find that the Examiner has met this burden. The Examiner has not established why one of ordinary skill in the art would not recognize in the Specification, through its specific definitions of polymers, a description of the invention defined by the claims.

CONCLUSION OF LAW

Appellants have demonstrated error in the Examiner’s written description rejection. The written description rejection is reversed.

REVERSED

dm

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